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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 10/807,018

Filed: March 23, 2004

For: Shingle With Sharply Defined Tabs Separated
by Slots and Method of Making

Inventors: Husnu M. Kalkanoglu, et al

Examiner: Parker, Frederick John

Art Unit: 1762

Atty. Doc. No.: 116-03

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- (1) Cover Letter with Express Mailing;
- (2) Appeal Brief Volume 1 comprising sections:
 - A-K of 19 pages
 - Claims Appendix-pgs. 20-23
 - Evidence Appendix pg. 24 including:
 - Snyder Declaration (12pgs) with Exhibits A-C
 - Jenkins Declaration-2pgs
 - Koschitzky 5,664,385
 - Pages 1-2 of application (Admitted Prior Art)
 - Related Proceedings Appendix pg. 25
- (3) Appeal Brief Volume 2;
 - 51 patents from paragraph 12 of Snyder Declaration;
- (4) Credit Card Payment Form (\$510.00);
- (5) Paul & Paul Postcard to be returned by the PTO.

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Respectfully submitted,

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PATENT
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A. IDENTIFICATION PAGE

Serial No.: 10/807,018

Filed: March 23, 2004

For: Shingle With Sharply Defined Tabs Separated by Slots and Method of Making

Inventors: Husnu M. Kalkanoglu and Robert L. Jenkins

Examiner: Parker, Frederick John

Art Unit: 1792

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APPEAL BRIEF

Volume 1 of 2, including Appendix Sections L, M and N.

Volume 2 includes Appendix Section O.

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C. REAL PARTY IN INTEREST

The real party in interest is CertainTeed Corporation, a corporation of Delaware, having a place of business in Valley Forge, Pennsylvania, the Assignee of this application and of the invention to which it relates. CertainTeed Corporation is a subsidiary of Saint Gobain Corporation, a corporation of Pennsylvania, having a place of business in Valley Forge, Pennsylvania. Saint Gobain Corporation is an indirectly wholly owned subsidiary of Compagnie de Saint Gobain, a French company headquartered in Paris, France.

D. RELATED APPEALS AND INTERFERENCE

None

E. STATUS OF CLAIMS

The claims in the application originally were claims 1-13.

Claims 1-11 stand finally rejected.

Claims 12 and 13 are cancelled.

F. STATUS OF AMENDMENTS

There were no amendments subsequent to the Final Rejection of February 6, 2008. The claims were last amended on December 22, 2006, in response to the Official Action of September 27, 2006.

G. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is a method of making a shingle having multiple tabs separated by slots wherein adjacent tabs on each side of one or more slots have different aesthetics (for example, difference colors), and there are areas between where adjacent tabs are to be cut out to form slots, wherein aesthetics (such as colors) from the adjacent tabs are blended together. These blended-together areas are completely cut out when making the slots, such that the adjacent tabs are sharply defined in terms of their different aesthetics (such as color, gradation, etc.)

Independent claim 1, for example is directed to a method of making a shingle 40 with a butt portion 17 and a tab portion 18. The tabs in the tab portion are spaced apart by slots 27. Adjacent tabs having different aesthetics are sharply defined. The method

includes the steps of providing a web 10 of a hardenable adhesive-coated material to upper and lower surfaces (p. 4, L 2-7), with the web 10 being conveyed longitudinally (13 of Fig. 1; p. 4 L 10-14). Granules of a first aesthetic (A of Fig. 2; p. 4 L 17-27) are applied to a tab portion, and granules of a second aesthetic (B of Fig. 2; p. 4 L 17-27) are applied to another tab portion, and granules (B A of Fig. 2; p. 5 L 22-p. 6 L13) of a mixture of granules (B) and (A) are applied onto the tab areas in between the places where granules (A) and (B) were applied. Transverse slots 27 are then cut in the intermediate area (B A), with the slots 27 being at least as wide as the intermediate areas leaving visually sharp, precise starting and ending delineations at the ends of the tabs remaining after the slots 27 are cut. See Figs. 1, 2 and 4 below.

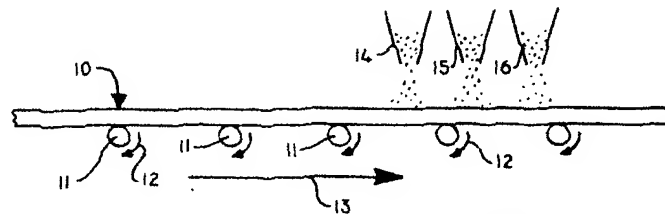


FIG. 1

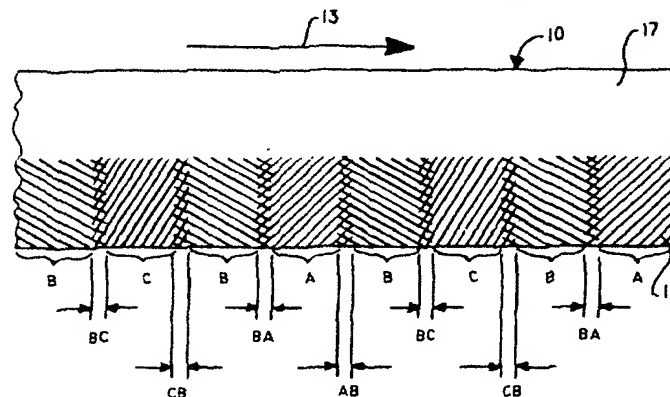


FIG. 2

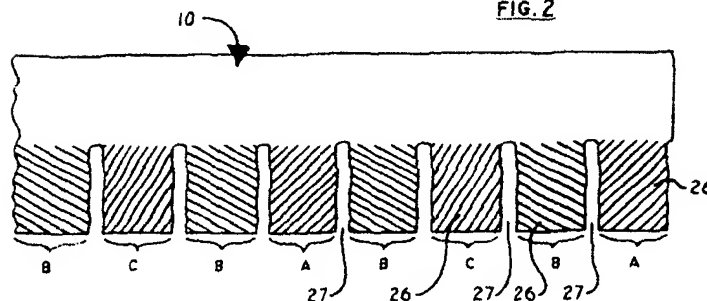


FIG. 4

Independent claim 3 is like independent claim 1, except that, instead of reciting that the slots that are cut are at least as wide as the intermediate areas, instead recites substantially the same thing in terms of completely removing the given width of the intermediate areas.

Independent claim 5 is like each of independent claims 1 and 3, except that where the removal of the slots is recited, instead of reciting it as in claim 1, the removal of the slots is recited as completely removing the intermediate areas.

Claims 2, 4 and 6, while not being independent claims, each recite the application of a third aesthetic area (C of Fig. 2).

H. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1 through 7 and 11 are unpatentable over Koschitsky U.S. 5,664,385 under 35 U.S.C. §103(a);
2. Whether claims 8 through 10 are unpatentable over Koschitsky in view of the Admitted Prior Art under 35 U.S.C. §103(a). The Admitted Prior Art discloses that it is known to form laminated shingles from two or more layers of shingle components.

I. ARGUMENT: THE REJECTION OF CLAIMS 1-7 AND 11 UNDER 35 U.S.C. §103 (a) OVER KOSCHITSKY 5,664,385 IS REVERSIBLE ERROR

1. **It is reversible error as a matter of law to read into Koschitsky a critical feature of the invention that is not there and which Koschitsky teaches away from, over and over and over again.**

In the Final Rejection, the Examiner reads into Koschitsky the *complete* removal of the transition areas between the tabs of Koschitsky.

There is no such disclosure whatever in Koschitsky.

Rather, Koschitsky teaches away from the complete removal of the transition areas.

Koschitsky specifically wants the *opposite* of complete removal of the transition areas; namely to retain blended parts of the transition areas on each side of each of the slots.

Koschitsky goes on to state (Column 5, lines 17-18) "...remove **the part** of the transition area where the two blends are approximately equal." (emphasis added).

Again, in Column 5, lines 26-29 Koschitsky states that "...it will remove **portions** of the transition area 36 where the granules from each blend 26a", 26b" have approximately a 50:50 ratio (as indicated by point 80 in Fig. 4 of Koschitsky). (emphasis added).

Again, Koschitsky goes on to say in Column 5 lines 29+ that "...the **portion** 36a of the transition area to the left of the left hand slot 76 in Fig. 7 will be predominantly determined by the color of blend 26a", while **the portion** 36b of the transition area to the right of the left hand slot 76 will be largely determined by the color of blend 26b". (emphasis added).

Koschitsky continues to go on to say:

The portions 36a, 36b of the transition area which remain after the slot has been cut will not be noticed by the eye, because of the presence of the slot 76. (Column 5 lines 35-37)

Again, Koschitsky is clearly emphasizing that there will be portions of the transition area that are **not** removed.

Thus, over and over and over again Koschitsky emphasizes that there is only a portion of each transition area that is removed.

Moreover, if one wishes to fully understand the goal of Koschitsky, one should look to claim 1, which is the broadest claim for which protection has been sought by Koschitsky.

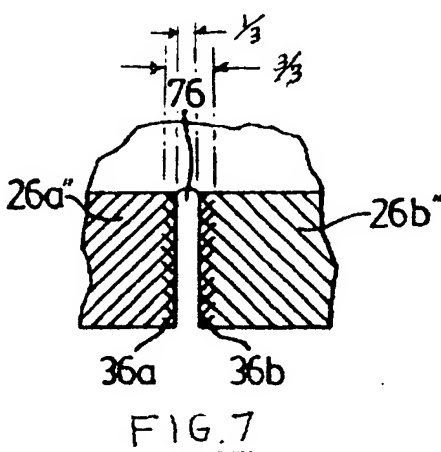
Claim 1, in Column 8 lines 11-16 states:

...each transition area also containing an intermediate portion between said border areas where granules from both said neighboring patches are present in substantial concentrations, said shingle having narrow slots between substantially all of said patches of granules...

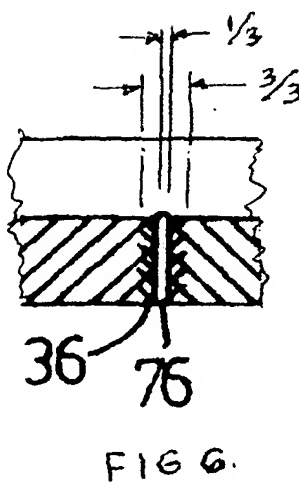
And lines 18-23 go on to state:

said slots extending **within** said intermediate portions of said transition areas but said transition areas **being of greater width than said slots so that there is a portion of a transition area on each side of each slot...**(emphasis added).

Additionally, if one looks to the drawings of Koschitsky, they also fully support that Koschitsky intends to retain some portions of the transition area on each side of the slot. See Fig. 7 of Koschitsky reproduced below, where Koschitsky shows that regions 36a and 36b are clearly noticeable as is shown by the hatch marks on each side of the slot. It is clear that the slot 76 of Koschitsky occupies only one third of the transition area and that an additional two thirds of the transition area is occupied by the remaining portions of the transition area that are **not** removed.



The same is true in the reproduced portion of Fig. 6 of Koschitsky below, where the slot 76 show hatched portions 36 of the transition area between adjacent tabs, and which are not removed.



In the illustrations from Koschitsky of Figs. 7 and 6 reproduced above, the undersigned has added lines and numbers showing that only about one third of each of the transition areas are removed.

In the Final Rejection, the Examiner states that column 5, line 4 + states “slots 76 are located in all or substantially all of the transition areas 36 between adjacent colored areas...” Such reference in Koschitsky to “all of the transition areas 36” refers to the **number** of areas; not the entire width of any given area.

The critical feature of complete removal of all of the transition areas is nowhere disclosed in Koschitsky and Koschitsky over and over and over again teaches away from such a feature. Doing what the prior art tries to avoid is the very antithesis of obviousness. *In re Buehler* 515 F.2d 1134, 1141 , 185 U.S.P.Q. 781, 787 (C.C.P.A. 1975).

It is submitted that the Examiner’s reading of Koschitsky is reversible error.

2. It is reversible error as a matter of law for the Examiner to misapply KSR as though Applicants were urging that “...a specific teaching, suggestion or motivation is required to establish a prima facie case of obviousness”, where Applicants make no such argument, and in the face of Applicants having already represented to the Examiner that they were not urging that a teaching is required, specifically citing KSR.

In numbered paragraph 4 of the Final Rejection, the Examiner states:

Applicants are reminded that KSR 82 USPQ2d 1396 forecloses the argument that a specific teaching, suggestion, or motivation is required to establish a prima facie case of obviousness.

But Applicants here do not argue that a specific teaching must be provided by the Examiner of making the modification that the Examiner would have to make to Koschitzky. Rather, Applicants here argue that Koschitzky itself leads away from the teaching of complete removal of the transitional areas.

In Applicants’ earlier remarks filed December 18, 2007, Applicants specifically pointed that out to the Examiner, but the Examiner has nevertheless repeated that argument in the Final Rejection.

3. It is reversible error as a matter of law for the Examiner to ignore that the Court in KSR repeated and reinforced the admonition from *Graham v. John Deere Co.* that the fact finder should "...guard against slipping into use of hindsight"...and should ... "resist the temptation to read into the prior art the teachings of the invention in issue".

In *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007) the U.S. Supreme Court also cited *Graham v. John Deere Co.* 383 U.S. 1, 15 Led 2d 545, 86 SC 684 for the proposition that the fact finder should "guard against slipping into use of hindsight"...and should..." resist the temptation to read into the prior art the teachings of the invention in issue." It is submitted that this admonition from *Graham v. Deere* that is reinforced by the Supreme Court in the *KSR* decision is quite applicable here, and that the Examiner should resist reading into Koschitzky that which is taught by the Applicants in the instant application, especially where Koschitzky goes to such great lengths throughout its text and illustrations, to retain on each side of the slot, portions of the transition areas, and where Koschitzky in fact teaches the retention of most of every such transition area.

Complete removal of the intermediate areas is taught in Applicants' own disclosure which may not be relied upon, but apparently is being relied upon for a teaching of modifying Koschitzky, because, on this record, it is Applicants' application that teaches this feature.

4. It is reversible error as a matter of law for the Examiner to apply an out-dated, pre-1952 Patent Act test for patentability under *In re Seid* as though structural features having aesthetic purposes cannot be a basis for patentability in a utility patent.

On page 3 of the Final Rejection, the Examiner states:

Matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, quoting *In re Seid* 73 USPQ 431

In re Seid was decided in 1947, more than 60 years ago, before the 1952 Patent Act. The 1952 Patent Act disposed of a prior collection of negative rules for patentability. Those negative rules do not exist today. Rather, the test for patentability under the 1952 Patent Act is that set forth in 35 U.S.C. §103, and is a test of obviousness versus unobviousness.

The Board of Patent and Appeals in *In re Seid* was addressing the pre-1952 standard of what constitutes invention, a test that has long been laid to rest. Actually, the Examiner has mis-quoted *In re Seid*. The Board in *In re Seid* was not addressing whether there was produced a new mechanical effect or advantage considered to constitute *the* invention. Rather, it was addressing whether the effect or advantage was considered to *constitute invention*, using the pre-1952 test for patentability. The full quote, accurately presented is:

The Board stated that the shape of the hollow member
“is a mere matter of choice in ornamentality and produces
no mechanical effect or advantage considered to constitute
invention”.

The Court of Customs and Patent Appeals in *In re Seid*, in affirming the Patent Office Board of Appeals, was applying the pre-1952 test for patentability as to whether or not the differences did “constitute invention” under the test at that time.

That is not the test today.

On page 6 of the Final Rejection, the Examiner again refers to *In re Seid*, again for the proposition that structural features that produce aesthetic differences are not patentable, suggesting that because they are aesthetic they are inherently obvious. But the Patent Office has been regularly granting patents on that basis for the last 50 years, as will be addressed in subparagraph 5, below.

Even if *In re Seid*, as addressed by the Examiner for the proposition that some functional feature is required for patentability in a utility patent was still viable law under 35 U.S.C. 103, that proposition is satisfied by the functional aspects of the invention at issue here.

Paragraphs 4 and 5 of the Snyder Declaration, of record, address at least nine functional features of the invention set forth in the claims. They are summarized here as follows, as producing a number of mechanical and functional effects and advantages.

In paragraph 4 of the Snyder Declaration, these mechanical and functional effects and advantages for the cutting of the slots are set forth as follows:

- (a) the cutting of the slots allows for thermal expansion of the tabs in the longitudinal direction under hot roof conditions, such as occurs in elevated temperature conditions, especially during summer in southern geographic areas of the U.S., allowing for leftward and rightward movement of the tabs, rather than buckling of the tabs;
- (b) the cutting of the slots prevents upward bowing of the exposed-wind-installed portion of the shingles under conditions of thermal expansion;
- (c) the cutting of the slots accommodates the shingles conforming to non-planar surface portions of roofs on which they are installed;
- (d) when shingles are being applied over other, pre-existing shingles in re-roofing conditions, the cutting of the slots accommodates the shingles conforming to surface irregularities of pre-existing shingled roofs, and
- (e) the cutting of the slots, at their upper ends, of a given course of shingles, helps in aligning a next-overlying course of shingles.

In paragraph 5 of the Snyder Declaration, these mechanical and functional effects and advantages are set forth as follows for the application of granules:

- (a) preventing ultraviolet UV radiation from degrading the asphalt;
 - (b) providing bulk and thickness to shingles that make them more difficult for wind to lift tabs thereof and possibly break the tabs, causing leakage;
 - (c) providing bulk to shingles for easier handling upon installation;
- and
- (d) providing an intermediate layer between overlapping shingles that prevents the asphalt layers on shingles from sticking together when adjacent shingles are packaged in overlying relation for shipment.

Accordingly, even under the now-extinct test of *In re Seid*, the claims of this application meet that test. The rejection of the claims under 35 U.S.C. 103, to the extent that it is based upon *In re Seid*, is submitted to be reversible error as a matter of law.

5. It is reversible error as a matter of law for the Examiner to dismiss out of hand the practice of the USPTO for the last 50 years since *In re Seid* and the evidence exemplified by the collection of 51 patents cited in the Snyder Declaration that recognize that ornamental and aesthetic features in utility patents for shingles are bases for patentability.

In paragraph 12 of the Snyder Declaration, of record, there are 51 patents listed, all directed to shingles or roof structures or the process of making them. Every one of these is directed to aesthetic or ornamental aspects of the shingles, because that has been the nature of shingle development for more than the last 50 years.

Typically, shingle development has been to make asphalt shingles, of either the single or multi-layer type, that simulate natural materials, such as simulating flagstone, cedar shakes, or tiles. Many of these inventions relate to producing some visual aspect of the shingle that simulates thickness where the shingles are actually thin. Others simulate curvature where there is no curvature. Others provide a rough appearance when they are not very rough. Others simulate alternating ridges and valleys. Others add shadow lines. Some simulate thatched roofs.

These simulations have been the nature of a large portion of shingle development, including development in the patent art, over many years. They accomplish this by building into the manufacture of a shingle some structural feature(s), not present in the art, that gives a different appearance.

The U.S. Patent Office has applied the standard of obviousness under Section 103 and in every one of the 51 cases listed in paragraph 12 of the Snyder Declaration, has concluded that the inventions listed have passed the tests for novelty and unobviousness, notwithstanding that the goal in each case has been to produce some ornamental or aesthetic feature.

While the Examiner, in the paragraph bridging pages 6 and 7 of the Final Rejection, notes the ornamentation effects of those inventions of the 51 patents listed in paragraph 12 of the Snyder Declaration, and has appreciated the well written and concise summary of those developments **having aesthetic purposes**, the Examiner nevertheless seeks to collectively distinguish all of those from the invention at issue here by concluding at the outset that those 51 items are “inventive methods for forming unexpected appearances for roofing” and assumes the conclusion with respect to the

invention at issue here, concluding that such is “only an obvious variation of what the prior art already teaches”, **simply because the present invention has an aesthetic purpose.**

It is submitted that *In re Seid* presents no basis for ignoring the complete removal of the transition areas to get the aesthetic effect that such produces any more than *In re Seid* would have been a basis for ignoring the structural features of the various 51 patents cited, that produced the ornamental and aesthetic effects set forth as being desirable for those 51 patents collected and referenced in paragraph 12 of the Snyder Declaration.

It is submitted that it is reversible error for the Examiner to have applied a different legal standard for the applicant here than the Patent Office has been applying for more than the last 50 years in the roofing art.

Under the Examiner’s application of *In re Seid*, even the Koschitsky invention of U.S. patent 5,664,385, would be precluded from patentability, because the structural feature of that invention, addressed over and over and over in Koschitsky, is to remove a portion of the transition areas of adjacent tab portions (to accentuate the visual demarcation between adjacent differently colored areas of granules). Thus, Koschitsky would also be barred from patentability under the Examiner’s proposed, improper application of the pre-1952 Act test for whether or not the differences between Koschitsky and the prior art “constitute invention”.

6. It is reversible error as a matter of law for the Examiner to misstate the opinion of Mr. Snyder that the present invention is not obvious because it is not “expressly” taught in the art; rather, Mr. Snyder testified that the invention is not obvious over Koschitsky based upon his 34 years experience in this art.

On page 7 of the Final Rejection, the Examiner misstates Mr. Snyder’s opinion to the effect that Mr. Snyder supposedly states that the “...instant claims are not obvious because they are not expressly taught in the prior art”, citing paragraph 21 of the Snyder Declaration.

That is not what Mr. Snyder attested to. He did not base his opinion on the fact that they were not “expressly” taught in the prior art.

Rather, he testified:

Considering the failure of Koschitzky and the other art

referenced in paragraph 12 of this Declaration to teach the present invention, it is my opinion based upon my experience in the shingle art that this invention is not obvious.

Thus, Mr. Snyder's opinion as to non-obviousness was ¹ not in any respect based upon the fact that the particular novelty of this invention was not *expressly* taught in the prior art. Rather, it was an opinion based upon his intimate involvement in the roofing industry for over 34 years, being very familiar with patents in the roofing industry, and being a patentee himself, as addressed in numbered paragraph 1 of his declaration.

It is submitted that it was reversible error for the Examiner to Final Reject the claims of this application based upon the narrow basis for a holding of non-obviousness that was not the basis for Mr. Snyder's opinion. Mr. Snyder's opinion was not limited to "expressly"; rather, it is based upon his broad experience over many years in the shingle art.

7. It is reversible error as a matter of law for the Examiner to dismiss the evidence of commercial success as a secondary consideration under *Graham v. John Deere Co.* Having first dismissed the evidence of commercial success provided by Mr. Snyder on the grounds that potential factors of promotion, advertising and marketing were not addressed, the Examiner then ignores the evidence provided by Mr. Jenkins that the factors of promotion, advertising and marketing were the same for the shingle of this invention as for the comparison commercially successful shingle. Nowhere does the Examiner address that his earlier concern as to these factors were fully answered in a subsequent declaration.

Evidence of commercial success was provided to the Examiner in paragraph 20 of the Snyder Declaration. The evidence was predicated upon a comparison of the commercial success of a product made in accordance with the claims of the instant application, with another shingle of CertainTeed that has been a commercial success over 15 years. The commercial success enjoyed by the shingle of the instant

1. In paragraph 14 of the Snyder Declaration, there is a typographical error in line 6, where "incomplete" was mistakenly typed as "complete". The next 4 lines of that paragraph makes it clear that Mr. Snyder was testifying that the Koschitsky removal of the intermediate areas was incomplete, as does the last four lines of paragraph 18 of the Snyder Declaration.

invention over less than 4 years, compared with the 15 year period for the comparison shingle, was referred to by Mr. Snyder as “stunning”. Mr. Snyder summarized that “stunning” success as follows:

In the short period of time that the shingle of this invention has been on the market, its year-to-date sales volume, as measured in squares, is already over 80% of the year-to-date volume of the other successful shingle that has been on the market for 15 years.

The Examiner had taken the position that Mr. Snyder had not addressed other possible considerations, such as promotion/advertising, market share, etc.

In response to that, a Declaration of Robert L. Jenkins was submitted, also a person of considerable experience, having spent over 25 years in the shingle industry, who also testified to his considerable experience with shingles in general, and his familiarity with shingles in accordance with this invention, in numbered paragraph 2 of his Declaration.

Regarding the factors of promotion, advertising and marketing, Mr. Jenkins testified that those factors were the same for the shingle of this invention as for the comparison shingle addressed by Mr. Snyder. as follows, in paragraph 5 of his declaration:

The factors of promotion, advertising and marketing that took place for the shingle of this invention from prior to its commercial release and thereafter were essentially the same as those factors for the comparison commercially successful shingle of CertainTeed to which the shingle of this invention is compared in paragraph 20 of the Snyder Declaration.

Thus, the testimony of Mr. Jenkins took out of play those factors that the Examiner had raised as not previously being addressed, as possibly having some meaning relative to the commercial success of the shingle of this invention, and established that these factors had no meaning for this invention.

However, in the Final Rejection the Examiner ignored the Declaration of Mr. Jenkins, making no mention of it whatever, and giving apparently no weight whatever to the fact that there were no differences in the levels of advertising, promotion, marketing,

etc. between the shingle of this invention which had its “stunning” commercial success, and the commercial success of the comparison shingle addressed by Mr. Snyder.

It is submitted that it is reversible error as a matter of law for the Examiner to have either ignored or dismissed out of hand the commercial success as a secondary consideration under *Graham v. Deere Co.* in support of patentability.

For all of the reasons set forth in subsections 1-7 of Argument section I, reversal of the Final Rejection of claims 1-7 and 11 over Koschitsky under 35 U.S.C. §103(a) is believed to be in order.

Claims 1,3 and 5 stand together, all requiring, by slightly different wording, the complete removal of the intermediate areas. Claims 2, 4 and 6 depend respectively on claims 1, 3 and 5 and add third primary (tab) areas to the first and second primary areas. Claims 2, 4 and 6 stand with claims 1, 3 and 5. Claim 7 adds to claims 1, 3 and 5 the cutting of the web into shingles and stands with claims 1, 3 and 5. Claim 11 depends from claim 7 and requires a varied parameter from tab to tab, such as tab length, tab width or slot width. Claim 11 stands with claim 7.

J. ARGUMENT: THE REJECTION OF CLAIMS 8-10 UNDER 35 U.S.C. §103 (a) OVER KOSCHITSKY 5,664,385 IN VIEW OF THE ADMITTED PRIOR ART IS REVERSIBLE ERROR

All of sections 1-7 of Argument section I, dealing with the deficiencies of Koschitsky as a basis for rejection are herein incorporated by reference.

The Examiner adds to Koschitsky the teaching from the Admitted Prior Art that laminated shingles can be made from two or more shingle layers.

However, claim 8 depends from and includes all of the limitations of claim 7, which, in turn, depends from and includes all of the limitations of any one of claims 1, 3 and 5, and additionally requires that there be a second layer of impregnated reinforcing material with granules thereon to the base web of impregnated reinforcing material with granules thereon, to make a laminated shingle.

In Exhibit B to the Snyder Declaration filed August 24, 2007, there is provided an actual specimen of a shingle of this invention, in which such a laminated layer is applied to the rear of the layer having slots therein. A photograph of that Exhibit B is provided in Exhibit C to the Snyder Declaration, also showing the lamination behind the main layer of shingle material.

In each of Exhibits B and C to the Snyder Declaration, the granules appearing on the rear layer of shingle material are very dark. This enhances the aesthetic effect provided by the shingles made in accordance with any of claims 1, 3 and 5, where the sharp, precise lines of delineation that are made possible by removal of the complete intermediate areas when the slots are made in the top shingle layer, allow for the granules on the top surface of the rear shingle layer to appear in the slot, thereby providing an enhanced aesthetic feature of the invention due to the combination of the granules on the front surface of the rear layer of shingle material being visible through the slots in the front layer of shingle material that completely remove the intermediate layer.

This presents an additional reason for patentability of claim 8 over and above the reasons advanced above with respect to the patentability of independent claims 1, 3 and 5.

Claim 9 adds to claim 8 the feature that the second layer (the rear layer shown in Exhibits B and C of the Snyder Declaration) is applied after the intermediate areas of the front shingle layer are removed. This is a process limitation that further limits the scope

of claim 8, disclosed nowhere in the art of record. Thus, claim 9 contains a limitation that presents an additional reason for patentability, over and above that of claim 8.

Claim 10 likewise includes a process limitation, but wherein the second layer of impregnated reinforcing material with granules is applied before the intermediate areas are removed, thus further limiting the scope of claim 8, but in a different sequence than that set forth in claim 9. Nowhere in the art of record is the sequence required by claim 10 disclosed. Therefore such presents an additional reason for the allowance of claim 10, over and above claim 8.

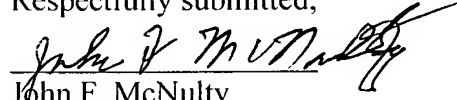
For the reasons advanced above, it is submitted that the rejection under Section 103 over Koschitsky in view of the Admitted Prior Art, is reversible error and those claims should be allowed as well.

K. CONCLUSION

The rejections of the claims of this application under 35 §U.S.C. 103 are in error as a matter of law and should be reversed.

For the reasons set forth in the Argument sections I and J above, the rejections should be reversed as a matter of law and the application proceed to issuance.

Respectfully submitted,



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L. CLAIMS APPENDIX

An accurate copy of claims 1-11 of this application is herewith presented:

1. A method of making a shingle having a butt portion and a tab portion with tabs of desired aesthetic in the tab portion being spaced apart by slots, and with adjacent tabs being sharply defined, comprising the steps of:

- (a) providing a base web of reinforcing material impregnated with and coated with an adhesive material as a hardenable coating, to an upper surface and a lower surface thereof;
- (b) conveying the impregnated reinforcing material in a longitudinal direction;
- (c) applying granules of a first aesthetic onto the hardenable coating on the upper surface in first primary areas, each of a first width, in the tab portion of the continuous strip of shingle material, to cover said first primary areas;
- (d) applying granules of a second aesthetic onto the hardenable coating of the upper surface in second primary areas, each of a second width, in the tab portion of the continuous strip of shingle material, to cover said second primary areas; and
- (e) applying granules of a mixture of those applied to adjacent primary areas, onto the hardenable coating in intermediate areas between said adjacent primary areas, each intermediate area being of a given width; and
- (f) cutting generally transverse slots of a predetermined size in said tab portion so that each said slot is at least as wide in the longitudinal direction as the width of the entire intermediate area in which it is located, to remove said given width of intermediate areas, leaving visually sharp, precise starting and ending delineations at each longitudinal end of each of said primary areas, with granules of a given aesthetic in each primary area being spaced apart on longitudinally opposite sides of a said slot.

2. The method of claim 1, including the step of:

- (g) applying granules of a third aesthetic onto the hardenable coating of the upper surface in third primary areas, each of a third width, in the tab

portion of the continuous strip of shingle material, to cover said third primary areas.

3. A method of making a shingle having a butt portion and a tab portion with tabs of desired shading in the tab portion being spaced apart by slots, and with adjacent tabs being sharply defined, comprising the steps of:

- (a) providing a base web of reinforcing material impregnated with and coated with an adhesive material as a hardenable coating, to an upper surface and a lower surface thereof;
- (b) conveying the impregnated reinforcing material in a longitudinal direction;
- (c) applying granules of a first aesthetic onto the hardenable coating on the upper surface in first primary areas, each of a first width, in the tab portion of the continuous strip of shingle material, to cover said first primary areas;
- (d) applying granules of a second aesthetic onto the hardenable coating of the upper surface in second primary areas, each of a second width, in the tab portion of the continuous strip of shingle material, to cover said second primary areas; and
- (e) applying granules of a mixture of those applied to adjacent primary areas, onto the hardenable coating in intermediate areas between said adjacent primary areas, each intermediate area being of a given width; and
- (f) completely removing said given width of intermediate areas.

4. The method of claim 3, including the step of:

- (g) applying granules of a third aesthetic onto the hardenable coating of the upper surface in third primary areas, each of a third width, in the tab portion of the continuous strip of shingle material, to cover said third primary areas.

5. A method of making a shingle having a butt portion and a tab portion with tabs of desired shading in the tab portion being spaced apart by slots, and with adjacent tabs being sharply defined, comprising the steps of:

- (a) providing a base web of reinforcing material impregnated with and coated with an adhesive material as a hardenable coating, to an upper surface and a lower surface thereof;
- (b) conveying the impregnated reinforcing material in a longitudinal direction;
- (c) applying granules of a first aesthetic onto the hardenable coating on the upper surface in first primary areas, each of a first width, in the tab portion of the continuous strip of shingle material, to cover said first primary areas;
- (d) applying granules of a second aesthetic onto the hardenable coating of the upper surface in second primary areas, each of a second width, in the tab portion of the continuous strip of shingle material, to cover said second primary areas; and
- (e) applying granules of a mixture of those applied to adjacent primary areas onto the hardenable coating in intermediate areas between said adjacent primary areas; and
- (f) completely removing said intermediate areas.

6. The method of claim 5, including the step of:

- (g) applying granules of a third aesthetic onto the hardenable coating of the upper surface in third primary areas, each of a third width, in the tab portion of the continuous strip of shingle material, to cover said third primary areas.

7. The method of any one of claims 1, 3 or 5, including the step of cutting the impregnated web with granules into separate shingles of predetermined lengths.

8. The method of claim 7, including the step of applying a second layer of impregnated reinforcing material with granules thereon to the base web of impregnated reinforcing material with granules thereon, to make a laminated shingle.

9. The method of claim 8, wherein the second layer of impregnated reinforcing material with granules thereon is applied after said intermediate areas are removed.

10. The method of claim 8, wherein the second layer of impregnated reinforcing material with granules thereon is applied before said intermediate areas are removed.

11. The method of claim 7, wherein said tabs of desired aesthetic have a varied parameter from one tab to another, said varied parameter being selected from the group of tab shape, tab length, tab width and slot width.

12. (Cancelled)

13. (Cancelled)

M. EVIDENCE APPENDIX

The evidence appendix includes the following:

- M1. Declaration of Richard Allan Snyder of August 17, 2007, and Exhibits A-C thereto.
- M2. Declaration of Robert L. Jenkins of December 17, 2007.
- M3. Copy of Koschitsky patent 5,664,385.
- M4. Copies of pages 1 and 2 of the instant patent application as filed, containing the “Admitted prior Art” relied upon by the Examiner for the rejection of claims 8-10 under 35 U.S.C. §103(a) as being unpatentable over Koschitsky in view of the Admitted prior Art.